

**REMARKS**

In response to the Office Action dated October 13, 2010, Applicant has amended the claims, which when considered with the following remarks, is deemed to place the present application in condition for allowance. Favorable consideration and allowance of all pending claims is respectfully requested. The amendments to the claims are non narrowing amendments and have been made in the interest of expediting prosecution of this case. Applicant reserves the right to prosecute the same or similar subject matter in this or another application.

It is noted with appreciation the withdrawal by the Examiner of the previous objections and rejections set forth in the Office Action dated April 16, 2010.

Claims 1-21 are pending in this application. By this Amendment, Claims 1, 19 and 20 have been amended to correct antecedent basis issues. Accordingly, it is respectfully submitted that no new matter has been added to this application nor have any new issues been raised by these amendments. Thus, entry and consideration of the subject Amendment is deemed appropriate as it places the application in condition for allowance.

In the last Office Action mailed October 13, 2010, the Examiner has rejected Claims 1-21 under 35 U.S.C. §103(a) as being unpatentable over Francisco et al. U.S. Patent No. 5,308,522 ("Francisco et al.") in view of Kolosov et al. U.S. Patent Application No. 2004/0123650 ("Kolosov et al.") and further in view of Chaffee et al. U.S. Patent No. 4,774,281 ("Chaffee et al.") taken in view of Migdal et al. U.S. Patent No. 5,062,980 ("Migdal et al.") and Wollenberg et al. U.S. Patent Publication No. 2008/0153716 ("Wollenberg et al.").

Nowhere do the combination of Francisco et al., Kolosov et al., Chaffee et al., Migdal et al. and Wollenberg et al. disclose or suggest a “high throughput method for screening lubricating oil composition samples for compatibility with elastomers, under program control, comprising the steps of: (a) conducting molecular modeling of at least one base oil of lubricating viscosity and at least one lubricating oil additive to provide leading candidates of the at least one base oil of lubricating viscosity and the at least one lubricating oil additive for combination to formulate a leading candidate lubricating oil composition sample for testing; (b) containing a plurality of the leading candidate lubricating oil composition samples comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive in varying percentages in a plurality of test receptacles; (c) providing at least one elastomer; (d) measuring the elastomer compatibility of each sample to provide elastomer compatibility data results for each sample; and, (e) outputting the results of step (d), as presently recited in amended Claim 1.

As acknowledged by the Examiner, the combination of Francisco et al., Kolosov et al., Chaffee et al. and Migdal et al. “do not teach the computer modeling and lead candidate oil mixtures in a plurality of test receptacles having varying percentages of additives such as set forth in claims 1a and 1b.” The Examiner then relies on Wollenberg et al. for the teaching of conducting molecular modeling of at least one base oil of lubricating viscosity and at least one lubricating oil additive to provide leading candidates of the at least one base oil of lubricating viscosity and the at least one lubricating oil additive for combination to formulate a leading candidate lubricating oil composition sample for testing. Applicant submits that Wollenberg et

al. are not prior art, as stated under 35 U.S.C. 103(c) and also MPEP §706.02(l)(1). That section of the statute states, in part:

(c) Subject matter developed by another person, which qualifies as prior art only under one or more subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed inventions were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The MPEP section states that the above-quoted 35 U.S.C. §103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999.

The present application was filed on February 13, 2004. Furthermore, the present application was, at the time the invention was made, subject to an obligation of assignment and was assigned to Chevron Oronite Company LLC, also the assignee of Wollenberg et al. Accordingly, it is submitted that Wollenberg et al. are not prior art. Thus, withdrawal of the rejection of Claims 1-21 under 35 U.S.C. §103 (a) is warranted and such is respectfully requested.

The Examiner has rejected Claims 19 and 20 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 19 and 20 have been amended in a manner believed to obviate this rejection. Specifically, Claim 19 has been amended to change the recitation “the result of step (c)” to the recitation “the results of step (d)” and Claim 20 has been amended to change the recitation “the result of step (d)” to the recitation “the results of step (e)”. As such, amended Claims 19 and 20 are believed to be sufficiently clear and definite as to comply with

Appln. No. 10/779,421  
Amdt. dated January 11, 2011  
Office Action dated October 13, 2010

the requirements for definiteness under the second paragraph of 35 U.S.C. §112. Accordingly, withdrawal of the rejection is respectfully requested.

For the foregoing reasons, Claims 1-21 as presented herein are believed to be in condition for allowance. Such early and favorable action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael E. Carmen', written in a cursive style.

Michael E. Carmen  
Reg. No. 43,533  
Attorney for Applicant

M. CARMEN & ASSOCIATES, PLLC  
1201 RXR Plaza  
Uniondale, NY 11556  
(Phone) (516) 992-1848  
(Facsimile) (516) 739-0981  
MEC:bg